

REMARKS**A. Amendments to the Claims**

Claims 1, 30, 58, 68, and 69 are amended.¹ Claims 1–12, 16–24, 30, 32–35, and 56–69 are to remain pending following entry of this amendment.

B. 35 U.S.C. § 102

In the final Office action of 6 June 2008 (the “Office Action”), the examiner rejects claims 1–12, 16–24, 30, 32–35, and 56–69 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,839,707 to Lee *et al.*² (Office Action at 2–3.) It is respectfully submitted, however, that Lee fails to teach or suggest several limitations of every claim.

Taking claim 1, for example, Lee fails to teach or suggest at least the following limitations:

- items of legal information that are associated with one or more respective topic tags and one or more respective type tags, each topic tag identifying a topic or subtopic associated with the associated item of legal information and each type tag identifying a type of legal information corresponding to the associated item of legal information;
- a database storing the legal information in association with a plurality of legal topics and a plurality of types of legal information; and

¹ The amendments herein are made without admission and without prejudice to the applicants’ right to pursue any or all subject matter deleted from the claims in one or more continuing applications. For purposes of determining the applicability to the claim amendments herein of *Festo Corp. v. Shoketsu Kizoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722 (2002), the applicants do not admit that any claim amendment was made to avoid prior art, or for a substantial reason relating to patentability, or to narrow the scope of any claim. The applicants do not waive any rights to any subject matter and specifically reserve the right to rebut in an appropriate proceeding any presumption that may arise that any claim has been amended so as to implicate the principles enunciated in *Festo*.

² In the Office Action, the examiner also rejected claims 63 and 64 under 35 U.S.C. § 112, second paragraph. Following entry of the amendment after final rejection dated 19 September 2008, this rejection was withdrawn in the advisory action of 29 September 2008. Only the rejection under section 102(e) remains outstanding.

- causing items to provided for display on a display device, automatically tabulated by the respective type tags.

As amended, claim 1 claims “item[s] of legal information,” each of which is:

associated with one or more respective topic tags and one or more respective type tags, each topic tag identifying a legal topic or subtopic associated with the associated item of legal information and each type tag identifying a type of legal information corresponding to the associated item of legal information.

Lee fails to teach or suggest the existence or use of any tags for any purpose, much less the topic tags and type tags claimed in the above-quoted section of claim 1. Rather than using tags, Lee discusses organizing documents using a “folder and file” structure, not tags. (Col. 9, lines 3–13.) Users maintain the organizational structure by adding, modifying, and deleting folders. (*E.g.*, col. 9, line 65–col. 10, line 13.) Documents may be added to folders, updated in folders, and deleted from folders. (*E.g.*, col. 9, lines 44–64.)

The failure to teach or suggest topic tags or type tags is underscored by Lee’s failure to teach or suggest any tool or method for associating documents with tags of any sort.

Moreover, as the applicant has demonstrated in previous filings in this matter, Lee fails to teach or suggest the existence of a plurality of legal topics or a plurality of types of legal information. Necessarily, then, Lee fails to teach or suggest type tags that identify a legal topic or subtopic associated with an item of legal information. Similarly, Lee necessarily fails to teach or suggest type tags that identify a type of legal information associated with an item of legal information.

As also shown in the applicant’s previous filings, Lee fails to teach or suggest a database storing the legal information in association with a plurality of legal topics and a plurality of types of legal information at least because it fails to teach or suggest so much as the existence of legal topics or types of information. The examiner has cited Fig. 6 of

Lee, noting the appearance of the words “antitrust” and “consumer law.” (Office Action at 17.) These do not denote legal topics in Lee, however, but are practice groups. (Col. 8, lines 27–36.) It is respectfully noted that claim 1 claims “a plurality of legal topics,” not “a plurality of things, some of which have the same names as legal topics.”

Figs. 10 and 11 of Lee illustrate the distinction. The user interface screen depicted in Fig. 10 is used to manage the organization of information related to multiple practice groups. Upon selection of a practice group in Fig. 10 of Lee, the user is shown the screen depicted in Fig. 11, which is used to manage the organization of information associated with that practice group. (Col. 9, lines 44–47.) The subfolders reflect the internal structure and operations of the practice group, including headings such as “Best Practices” and “Communications.” (Col. 9, lines 47–52.) Manifestly, none of the headings relates to any legal subtopics, contrary to what one might expect to find if the heading were the name of a legal topic, not a practice group.

Nor does Lee teach or suggest the existence of a plurality of types of legal information. A “type of legal information” within the meaning of claim 1 is not merely any classification of information. Indeed, the specification makes clear that a “class” of information is much broader than a “type.” The term “type of legal information” is consistently used in the application only to refer to classifications that relate to the legal import or authority of the legal information. (¶¶ 0008, 0015, 0021, and 0042.) The patent claims that explicitly recite types for inclusion in the plurality of types of legal information also consistently follow this usage. (See pending claims 2, 4, and 5.)

Lee fails to teach or suggest types of legal information, as that term is used in the present application. Although Lee does mention file types in one place (col. 9, lines 6–8), the context makes clear that Lee is discussing only types of computer files, not types of legal information. The discussion involves only the format in which data is represented, and Fig. 9 of Lee depicts a user interface screen that includes containers for holding data in such file formats. There is no suggestion of any classification of the information that the file represents, much less of the existence of types of legal information within the meaning of claim 1.

Additionally, amended claim 1 claims “caus[ing] each item of legal information . . . to be provided for display . . . automatically tabulated by the respective type tags.”

It is respectfully submitted that Lee fails to teach or suggest causing items to be provided for display on a display device, automatically tabulated by the respective type tags. As shown above, Lee fails to teach or suggest type tags as in claim 1 and therefore necessarily fails to teach or suggest automatic tabulation of items of legal information according to type tags. Moreover, as also shown above, Lee fails to teach or suggest the existence of a plurality of types of legal information and therefore necessarily fails to teach or suggest automatic tabulation of items according to respective tags identifying corresponding types of legal information.

In the Office Action, however, the examiner cites several portions of Lee that, in the examiner’s view, teach tabulation of items of legal information by type of legal information. The examiner asserts on page 15 of the Office Action, for example, that the grouping of several items of information under the heading “Practice Groups” is such a tabulation. “Practice Group,” in the examiner’s view, is the type of legal information, and the names of the practice groups are items of legal information.

What is not clear, however, is just how the heading “Practice Groups” can be considered a “type of legal information” within the meaning of claim 1. In ordinary usage, a practice group is not a type of legal information: the term “practice group” may typically refer to a group of people who commonly work together within a larger legal practice. Nor are the names of individual practice groups “items of legal information,” as that term is used in the application; they designate groups of people within a larger organization.

In connection with this limitation, the examiner also cites Lee at columns 7 and 8 and the accompanying Figs. 6 and 7. (Office Action at 3.) In columns 7 and 8, Lee discusses organizing headings by top-level logical groups and then by practice groups. But, as shown above, neither the logical groups nor the practice groups of Lee are “types of legal information” within the meaning of claim 1.

Fig. 6 of Lee, discussed previously, depicts a home page of an LMS according to Lee. The examiner asserts that the names of the practice groups (reference numbers 340,

350, 380, etc.) are the items of legal information, and the various headings (reference numbers 270, 274, 278, etc.) are the types under which the items are tabulated. (Office Action at 14.)

This is inconsistent with the examiner's view that the practice groups in Fig. 6 correspond to the legal topics of claim 1. The items of legal information, the legal topics, and the types of legal information are all mutually exclusive: an item of legal information cannot be a legal topic or a type of legal information, and a legal topic cannot be a type of legal information. Nothing, including the names of the practice groups, can be both the legal topics and the items of legal information of claim 1.

The names of the practice groups in Lee are in fact *neither* the legal topics nor the items of legal information. As already shown, the names of practice groups are not legal topics. Nor can they be types of legal information: types of legal information, as used in claim 1, are certain kinds of categories, as shown above, but these names in Lee are the names of practice groups within the business entity. Nor are the items under the other headings items of legal information. Some of these items are the names of other units within the business entity, and others refer to the subject matter of communications and notices having to do with the operations of the business entity.

Similarly, to treat the headings in Fig. 6 of Lee as types of legal information, as the examiner does (Office Action at 15–16), is inconsistent with both the ordinary use of the term and the way that term is used in the applicant's specification and claims. For example, the heading "Human Resources" of Fig. 6 cannot reasonably be considered a type of legal information when the items gathered under it include, e.g., "Executive Recruiters" and "People on the Move." To the contrary, as shown above, the headings are simply the top-level folders within a knowledge-management system, and they correspond to the organization of the business entity, not to types of legal information as in claim 1.

Fig. 7 of Lee, also cited by the examiner in connection with tabulation by types of legal information (Office Action at 3), fails to support the rejections. Fig. 7, according to Lee, depicts an example page of the LMS, dedicated to the intellectual property practice group. (Col. 8, lines 36–48.) The depicted items comprise various headings and

subheadings, and, as with Fig. 6, the organization of these items reflects the organization and activities of the practice group. The depicted headings of Fig. 7 are “Quality Initiatives,” “Practice Areas,” “Communications,” “Preferred Providers,” “Document Library,” and “Links.” It should be apparent that none of these names a type of legal information, neither within the ordinary usage of the term, nor as the term is used in the present application.

For at least the foregoing reasons, it is respectfully submitted that independent claim 1 is allowable over the cited art. Independent claims 30, 58, 68, and 69 include limitations that correspond to the limitations of independent claim 1 discussed above, and it is submitted that these claims are allowable for the reasons discussed above. Claims 2–12, 16–24, 32–35, 56–57, and 59–67 depend directly or indirectly on one of claim 1 and claim 58, and it is submitted that these claims are therefore allowable based on their inclusion of allowable subject matter.. Reconsideration and withdrawal of the rejection of these claims are therefore respectfully requested.

C. Conclusion

For these reasons, the applicants respectfully request that the examiner withdraw the rejections and allow the claims. Additionally, although the applicants have set forth arguments that in their view suffice to establish the patentability of the pending claims over the cited prior art, for the sake of brevity, they have not responded to each assertion that was made in the Office Action. The applicants reserve the right to assert additional grounds for the patentability of any or all claims, and any lack of specific response to any comment relative to patentability that was made in the Office Action is not to be interpreted as acquiescence in the substance of any such comment.

To expedite prosecution of this application to allowance, the examiner is invited to call the applicants’ undersigned representative to discuss any issues relating to this application.

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Respectfully submitted,

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